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Attorney Docket No. 018940-023 Patent



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Szuping Lu et al.

Application No.: 10/602,888

Filing Date: June 25, 2003

Title: GLYCIDYL (METH)ACRYLATE POWDER COATING COMPOSITIONS CONTAINING

Group Art Unit: 1712

Examiner: ROBERT E SELLERS

Confirmation No.: 2267

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ Terminal Disclaimer(s) and the ☐ \$65.00 (2814) ☐ \$130.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.
- ☐ Also enclosed is/are _____

- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$395.00 (2801) ☐ \$790.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted _____

_____ on _____
for which continued examination is requested.
- ☐ Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims		MINUS =	0	x \$50.00 (1202) =	\$ 0.00
Independent Claims		MINUS =	0	x \$200.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$360.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to Deposit Account No. 02-4800.
- ☐ Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: July 29, 2005

By Melissa M. Hayworth
Melissa M. Hayworth
Registration No. 45,774

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Patent Application of

Szuping Lu et al.

Application No.: 10/602,888

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For: GLYCIDYL (METH)ACRYLATE
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COMPOSITIONS CONTAINING

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) Examiner: ROBERT E SELLERS

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the Office Action dated June 29, 2005, Applicants submit the following response. Applicants respectfully traverse the restriction requirement set forth in the Office Action.

In the Office Action, the Examiner sets forth a restriction requirement among four (4) groups of claims:

Group I: Claims 1-9 and 23, drawn to a powder coating comprising a glycidyl (meth)acrylate resin and a curing agent, and a clearcoat produced thereby (claim 23), classified in class 525, subclass 327.3.

Group II: Claims 10-18, drawn to a glycidyl (meth)acrylate resin, classified in class 526, subclass 273.

Group III: Claims 19 and 20, drawn to a process for producing a glycidyl (meth)acrylate resin, classified in class 525, subclass 123.

Group IV: Claims 21-23, drawn to a process for producing a powder coating, classified in class 427, subclass 386.

Applicants respectfully assert that the inventions of Groups I, II, III, and IV should properly be examined together. The invention of Group I is directed to a powder coating comprising a glycidyl (meth)acrylate resin and a curing agent, and a clearcoat produced thereby; the invention of Group II is directed to a glycidyl (meth)acrylate resin; the invention

of Group III is directed to a process for producing a glycidyl (meth)acrylate resin, and the invention of Group IV is directed to a process for producing a powder coating.

Accordingly, Applicants submit that the inventions of Groups I, II, III, and IV are closely related and that a proper search of any of the claims should, by necessity, require a proper search of the others. Thus, Applicants submit that all of the claims can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained.

Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants' overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention. The alternative is to proceed with the filing of multiple applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Regardless of whether the inventions are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. MPEP § 803 requires that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the restriction requirement are requested.

Nevertheless, in order to comply with the requirements of 37 C.F.R. § 1.143, Applicant provisionally elect, with traverse, to prosecute the invention of Group II, namely claims 10-18, drawn to a glycidyl (meth)acrylate resin, for prosecution in the above-identified application.

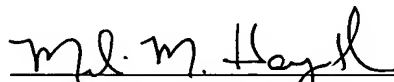
Applicants have no intention of abandoning any non-elected subject matter and should it be necessary, Applicants expressly reserve the right to file one or more continuation and/or divisional applications directed to non-elected subject matter.

Applicants earnestly solicit favorable consideration of the above response and early passage to issue the present application. The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 29, 2005

A handwritten signature in cursive script, appearing to read "Melissa M. Hayworth", is written over a horizontal line.

Melissa M. Hayworth
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